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Patent
Attorney Docket No. GEMS8081.023**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of : Durbin et al.
Serial No. : 09/681,017
Filed : November 22, 2000
For : Method and System To Remotely Enable
Software-Based Options For A Trial Period
Group Art No. : 3621
Examiner : Hewitt, C.

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

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REPLY BRIEF RESPONSIVE TO EXAMINER'S ANSWER
MAILED DECEMBER 3, 2004

Dear Sir:

This Reply Brief is being filed in response to the Examiner's Answer mailed
December 3, 2004.

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REMARKS**1. Response to Examiner's Grouping of the Claims Section**

The Examiner stated, "The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because Appellant argues separately claims 1, 8, 9, 10, 11, 18 and 23." December 3, 2004, Examiner's Answer, pg. 2. Appellant finds this statement inaccurate because (1) Appellant has met the requirements of MPEP §1206 to establish that claims 1, 8-10, 13, 10, 16, 18, and 23 do not all stand or fall together and (2) the Examiner's basis for disagreeing with Appellant's statements are favorable to a finding that claims 1, 8-10, 13, 10, 16, 18, and 23 do not stand or fall together. See April 21, 2004, Appeal Brief, pg. 4.

In particular, MPEP §1206 is clearly states, "For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless (1) a statement is included that the claims of the group do not stand or fall together and, (2) in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable." MPEP §1206 (Enumeration and emphasis added). In the Appeal Brief filed April 21, 2004, Appellant stated, "As will be particularly explained in the Argument Section, claims 1, 8-10, 13, 10, 16, 18, and 23 contain subject matter that is patentably distinct from the art of record" and "as will be shown below, claims 1, 8-10, 13, 10, 16, 18, and 23 do not all stand or fall together because at least each of these claims include subject matter that is patentably distinct from the art of record." April 21, 2004, Appeal Brief, pg. 4. Through these statements, Appellant complied with requirement "(1)" of MPEP §1206.

In support of the above-cited statements, Appellant included detailed arguments within the Argument Sections of the Appeal Brief filed April 21, 2004, and the Supplemental Appeal Brief filed September 15, 2004, that fully establish that claims 1, 8-10, 13, 10, 16, 18, and 23 each include subject matter that is patentably distinct from the art of record. See April 21, 2004, Appeal Brief, pgs. 4-14 and September 15, 2004,

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Supplemental Appeal Brief, pgs. 3-13. Therefore, Appellant fully complied with requirement "(2)" of MPEP §1206.

The Examiner's statement that "Appellant argues separately claims 1, 8, 9, 10, 11, 18 and 23" evidences Appellants compliance with MPEP §1206 in establishing that claims 1, 8-10, 13, 10, 16, 18, and 23 do not stand or fall together because the Examiner has acknowledged that Appellant separately explained why the claims are believed to be separately patentable. December 3, 2004, Examiner's Answer, pg. 2. As Appellant has complied with the standard outlined in MPEP §1206, claims 1, 8-10, 13, 10, 16, 18, and 23 do not stand or fall together.

2. Response to Examiner's Grounds of Rejection Section

Appellant agrees with the Examiner's recitation of the Grounds of Rejection as it is substantially a reiteration of the basis articulated in the Office Action mailed June 15, 2004. See June 15, 2004, Office Action. However, Appellant does note that, as later explained in the Response to Argument Section of the Examiner's Answer, the Examiner withdrew the objection to claims 18 and 22 under 37 CFR 1.75(c) and the rejection of claims 7, 12-14, 16, 17, and 26 under §112, first paragraph. December 3, 2004, Examiner's Answer, pg. 10. Appellant appreciates the indication by the Examiner that the remarks filed with respect to these objections and rejections were persuasive.

Regarding the remaining grounds of rejection proffered by the Examiner, Appellant believes that the arguments presented in the Appeal Brief filed April 21, 2004, and the Supplemental Appeal Brief filed September 15, 2004, fully traverse these rejections. Specifically, for at least the reasons presented in the Appeal Brief filed April 21, 2004, and the Supplemental Appeal Brief filed September 15, 2004, no basis of rejection can be sustained and claims 1-26 are in condition for allowance. See April 21, 2004, Appeal Brief and September 15, 2004, Supplemental Appeal Brief.

3. Response to Examiner's Response to Argument Section

REJECTIONS UNDER §101

The Examiner stated claim 18 is directed to non-statutory subject matter because "as claim 18 is dedicated to a computer program without computer readable medium,

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claim 18 is non-statutory." December 3, 2004, Examiner's Answer, pg. 10. To support this conclusion the Examiner cited a paragraph from MPEP §2106(IV)(B)(1)(a) that states:

Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and Office personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material. When a computer program is claimed in a process where the computer is executing the computer program's instructions, Office personnel should treat the claim as a process claim. See paragraph IV.B.2(b), below. When a computer program is recited in conjunction with a physical structure, such as a computer memory, Office personnel should treat the claim as a product claim.

MPEP §2106(IV)(B)(1)(a)

However, the paragraph immediately preceding that which was cited by the Examiner directs, "Office personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine." *Id.* To that end, the section continues by stating that "the claim remains statutory irrespective of the fact that a computer program is included in the claim" or "when a computer program is used in a computerized process *where the computer executes the instructions set forth in the computer program.*" *Id.* (emphasis added).

In the case at hand, claim 18 calls for "[a] computer program which, when executed by a computer, causes the computer to" complete a plurality of acts consistent with instructions embodied in the computer program. Claim 18. Therefore, in addition to the reasons previously presented in the Supplemental Appeal Brief filed September 15, 2004, claim 18 is directed to statutory subject matter under §101 because it meets the criteria set forth in the above-cited section of MPEP §2106(IV)(B)(1)(a). See September 15, 2004, Supplemental Appeal Brief, pgs. 4-5.

Additionally, Appellant notes that, though detailed arguments were presented with respect to the rejection of claim 23 under §101 in the Supplemental Appeal Brief filed September 15, 2004, the Examiner sustained the rejection but did not rebut or refute the arguments presented by Appellant. See September 15, 2004, Supplemental Appeal

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Brief, pgs. 5 and December 3, 2004, Examiner's Answer, pg. 10. Therefore, for at least the reasons presented in the Supplemental Appeal Brief filed September 15, 2004, claims 23-26 are in full compliance with §101. See September 15, 2004, Appeal Brief, pgs 3-4.

REJECTIONS UNDER §112, SECOND PARAGRAPH

The Examiner contended the rejection of claims 11-14 and 16-17 is supported because "one of ordinary skill is not provided with sufficient data to make and/or use the invention as Appellant's claims and Specification lack guidance regarding how the system is to perform if for example, the User ID is not validated." December 3, 2004, Examiner's Answer, pg. 11. Appellant reiterates the belief that the Examiner's position is without merit. Appellant has not claimed "If the user I.D. is not validated." Appellant is entitled to claim the invention as Appellant sees fit and is not required to claim or teach every possible contingency, for example, if the user I.D. is not validated. Rather, Appellant has claimed and, therefore, only seeks protection of steps that are to occur "if the user I.D. is validated." "If the user ID is not validated" is irrelevant.

Again, Appellant asserts that in order to practice the invention called for in claim 11 one of ordinary skill in the art would not need information regarding the "otherwise," as the Examiner contended. Further, Appellant emphasizes that fact that the "otherwise" is unclaimed, does not give the Examiner license to construe the claim "as if the user ID has not been validated" or provide a basis to neglect the examination of claims 12-14, 16, and 17. June 15, 2004, Office Action, pg. 4-5.

REJECTIONS UNDER §102(e)

When jointly addressing claims 1 and 23, the Examiner provided various new conclusions regarding that which the Examiner asserted is suggested by Neville et al. For example, the Examiner stated, "Regarding Appellant's 'confirming' step, the sever/clearinghouse initially receives a request from a user ('636, column 13, lines 57-59)" and that "[t]his is the first indication that the user is not using the software, otherwise, the user would not have a reason...to request an unlock key." December 3, 2004, Examiner's Answer, pg. 12. The Examiner then concluded from these statements that "[t]he 'confirmation' comes from the server/clearinghouse checking a use history

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database to confirm whether this is so ('636, column 13, lines 30-35; column/lines 13/60-14/3)." *Id.*

Appellant believes that the statements of the Examiner in no way show that Neville et al. teaches "at the centralized facility, confirming that the option has not already been enabled," as called for in claim 1 and 23. Claims 1 and 23. In fact, the Examiner's assertions are not consistent with the explicit teaching of Neville et al. That is, Neville et al. does not teach the element of "confirming that the option has not already been enabled" because if the execution controlled digital product were already activated, it would not request activation. That is, since the very digital product that requires an activation request also makes the request, it is unnecessary for Neville et al. to confirm "that the option has not already been enabled," as claimed.

The Examiner's position seems to suggest that Neville et al. teaches confirming non-use, i.e. "[t]his is the first indication the user is not using the software." December 3, 2004, Examiner's Answer, pg. 12. However, as evidenced by the lack of a citation to support this contention by the Examiner, Neville et al. does not teach "confirming" enablement or non-use. In fact, "confirming" or receiving a "first indication that the user is not using the software" is inconsistent with the system taught by Neville et al. because Neville et al. is specifically directed to a system for per-use "execution control" of a digital product. See Neville et al., col. 13, lns. 20-31. Why would a system that is focused on protecting against unauthorized use of a digital product be concerned with any indication that the user is not using the software? Therefore, contrary to the position of the Examiner, Neville et al. does not teach the claimed step of "confirming that the option has not already been enabled." Claims 1 and 23.

REJECTIONS UNDER §103(a)

When addressing claims 8 and 9, the Examiner stated, "To make their point, Appellant resorts to attacks on the Examiner." Responsive directly thereto, Appellant adamantly asserts that no "attack" was intended and deeply regrets that the Examiner perceived Appellant's presented position as an "attack."

As an *ex parte* proceeding, prosecution is, by definition, a non-adversarial proceeding. Therefore, Appellant's assertion of its position should not be interpreted as

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attack upon the Examiner. It appears that the Examiner took exception to Appellant's statement that, as a result of the proffered combination of references being so wholly unrelated, Appellant concluded that it appeared to be a result of a key-word search based on the present disclosure irrespective of the actual teachings of the references. Appellant's statements were made to illustrate (1) that a *prima facie* case of obviousness had not been established and (2) that impermissible hindsight had been used to construct the rejection. See April 21, 2004, Appeal Brief, pgs. 9-11 and September 15, 2004, Supplemental Appeal Brief, pgs. 9-10. These statements were in no way intended to question or attack the abilities or skills of the Examiner. Rather, Appellant only articulated its position and supported it with evidence from the record. Again, no attack or questioning of the Examiner's abilities was intended. Appellant regrets that the Examiner misconstrued Appellant's characterization of its position in favor of patentability as an impugning of the Examiner. Nevertheless, Appellant reiterates its position in favor of patentability and believes its position must be confirmed for the reasons previously presented as well as those herein. See April 21, 2004, Appeal Brief and September 15, 2004, Supplemental Appeal Brief.

Regarding claim 10, the Examiner stated that "storing a secret (eg encryption key) on a computer for any length of time, or reusing the same secret (eg encryption key) over and over again, increases the likelihood that the secret can be compromised" but that "this threat can be significantly decreased by generating a key 'on the fly', using 'one-time pads', or 'randomizing' the key by adding random bits." December 3, 2004, Examiner's Answer, pg. 13. However, as previously stated in the Supplemental Appeal Brief filed September 15, 2004, the conclusion proffered by the Examiner is unsupported by the art of record. See September 15, 2004, Supplemental Appeal Brief, pgs. 7-8.

Specifically, Neville et al. does not create an option key in response to an option request but is clear that any "unlock key" is created well before any request because Neville et al.'s unlock key is necessary to build the very execution controlled product that ultimately makes a request. See Neville et al., col. 10, lns 46-50. Therefore, the Examiner cannot assert that Neville et al. suggests creation of the option key *in response* to an option request. Therefore, for at least these reasons in combination with the reasons presented in the Appeal Brief filed April 21, 2004, and the Supplemental Appeal Brief

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filed September 15, 2004, claim 10 is patentably distinct from the art of record. See April 21, 2004, Appeal Brief and September 15, 2004, Supplemental Appeal Brief.

Regarding claim 11, the Examiner asserted, "Unlike claim 18, the Appellant has neglected to include how the system is to perform if certain conditions do not hold." December 3, 2004, Examiner's Answer, pg. 14. As such, the Examiner concluded that "giving the claims their broadest reasonable interpretation it would have been obvious to one of ordinary skill not [to] perform any other validation if the user ID is not validated." Id.

However, as repeatedly articulated in the Supplemental Appeal Brief filed September 15, 2004, Appellant has neglected nothing. See September 15, 2004, Supplemental Appeal Brief, pgs. 7-8. Appellant has claimed, and the Examiner must consider, *only* the limitations expressly called for within the confines of the claims. Id. The fact that claim 11 does not claim steps performed "if certain condition do not hold" is irrelevant. The art of record does not teach or suggest the elements expressly called for within the confines of the elements of claim 11 and, therefore, the rejection of claim 11 cannot be sustained.

Regarding claim 13, the Examiner concluded, "It is an undisputable fact that Appellant's 'medical equipment' is a computer...if for no other reason than [sic] it runs software." December 3, 2004, Examiner's Answer, pg. 14. First, Appellant does not believe that such can be characterized as "an undisputable fact" based on one reference, which the Examiner did not provide with the Examiner's Answer. Second, Appellant does not believe the Examiner's basis for the conclusion is supportable.

Appellant believes a plethora of devices "run software" and yet would not be indisputably characterized as a "computer." For example, it is common that modern automobiles, in some form or another, "run software" and yet one would not refer to driving one's computer to a destination. That is, the automobile may include a computer that "runs software", however, it cannot be said that the automobile, though it may include a computer, is itself a computer. Therefore, the claimed "medical equipment" may interact with a computer or even include a computer but it is not an undisputable fact that the "medical equipment" is a computer.

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Regarding claim 18, the Examiner concluded that since claim 18 "uses the term 'any'...it reads on a system without other option requests." December 3, 2004, Examiner's Answer, pg. 15 (emphasis in the original). From this conclusion, the Examiner then concluded that "to one of ordinary skill the claim *suggests* in this instance the generating and forwarding of the option key to the user. *Id* (emphasis added). Appellant finds these statements both perplexing and incorrect.

The Examiner appears to believe that by including the word "any" within a claim element, it renders the element meaningless. However, the term "any" adds meaning to the claim and the Examiner has not provided any support in the MPEP or in case law to conclude that the term "any" provides support for ignoring the term or the element in which the term is contained. Additionally, though the Examiner's statements purport to be supported by the "suggestions" of the claim, the claim does not "suggest" anything. The claim affirmatively calls for elements and each element must be considered and given full meaning. However, claims do not "suggest" and any supposed "suggestion" cannot be said to provide a basis for rejection.

Claim 18 calls for the computer to be caused to "compare the option-enabling request with any other option requests for that system I.D. in the database at the on-line center." Claim 18. Therefore, to support any rejection of claim 18 under 35 U.S.C. §103(a) the Examiner must establish that the art of record teaches or suggests a computer configured to be caused to "compare the option-enabling request with any other option requests for that system I.D. in the database at the on-line center." *Id*. However, the proffered rejection does not meet this standard. Rather, the Examiner has discussed what the Examiner believes is "suggested" by the claim and admittedly ignored explicitly claimed elements. When each and every element is properly considered, claim 18 is patentably distinct from the art of record.

4. Response to Examiner's Conclusion Section

The Examiner concluded the Examiner's Answer by stating that "Appellant's arguments are not persuasive in that they *intentionally misconstrue* the clear teachings of the prior art and do not give fair credit to the level and knowledge of those of ordinary skill in the computer and computer security art." December 3, 2004, Examiner's Answer,

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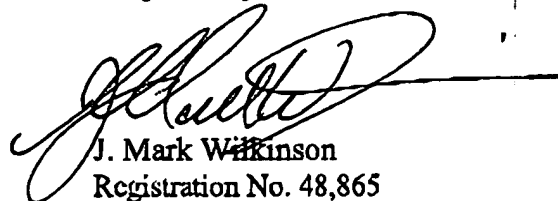
pg. 16. Appellant is taken aback by the Examiner's statement. Appellant vehemently objects to the Examiner's statement as inappropriate, inaccurate, and unfounded.

First, the Examiner's statement is unsupportable and, therefore, inappropriate. Such an accusation is serious and should never be made without full knowledge and evidence supportive thereof.

Second, just as Appellant would never "attack" or question the abilities of the Examiner, Appellant would never "intentionally misconstrue the clear teachings of the prior art" or intentionally fail to "give fair credit to the level and knowledge of those of ordinary skill in the computer and computer security art." *Id.* Rather, Appellant works diligently to accurately represent Appellant's position and understanding of both Appellant's own invention and any prior art as such is required of Appellant by the C.F.R. and MPEP and is clearly advantageous to Appellant in securing the strongest patent rights in light of the art of record.

For at least these reasons, Appellant believes the statements made by the Examiner in the Conclusion Section of the Examiner's Answer are inappropriate, inaccurate, and unfounded. See December 3, 2004, Examiner's Answer, pg. 16.

Respectfully submitted,



J. Mark Wilkinson
Registration No. 48,865
Direct Dial 262-376-5013
jmw@zpspatents.com

Dated: 1/26/05
Attorney Docket No.: GEM8081.023

P.O. ADDRESS:
Ziolkowski Patent Solutions Group, LLC
14135 N. Cedarburg Rd.
Mequon, WI 53097-1416
262-376-5170

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10. APPENDIX OF CLAIMS ON APPEAL

1. (Original) A method to remotely enable software-enabled options comprising the steps of:

receiving a user I.D. at a centralized facility from a user;

receiving an option-enabling request from the user specifying an option requested to be enabled in equipment at a subscribing station;

at the centralized facility, confirming that the option has not already been enabled;

sending an enabling feature from the centralized facility to the equipment in the subscribing station; and

activating the option in the equipment.

2. (Original) The method of claim 1 wherein the enabling feature is a software key designed to enable software already installed in the equipment.

3. (Original) The method of claim 1 where the enabling feature is software to run the feature in the equipment.

4. (Original) The method of claim 1 wherein the equipment includes medical imaging scanners.

5. (Original) The method of claim 1 further comprising the step of designing a software key to enable the option for a predetermined trial period.

6. (Original) The method of claim 1 further comprising the step of authenticating the user I.D. after receiving the user I.D. at the centralized facility.

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7. (Original) The method of claim 1 wherein the step of sending an enabling feature includes downloading the enabling feature to the equipment and remotely enabling the feature automatically and without further user input.

8. (Original) The method of claim 1 wherein the step of sending an enabling feature to the equipment includes sending the enabling feature by one of FTP and email to a field engineer for manual installation and enablement of the feature.

9. (Original) The method of claim 1 further comprising the step of:
verifying the option activation; and
sending a verification email to the user confirming option enablement.

10. (Original) An option-enabling system comprising:
a subscribing station having at least one in-field product and at least one computer programmed to control the in-field product;
an on-line center capable of receiving and authenticating a user I.D., validating an option request, and creating an option key in response thereto; and
a communications network to relay data from the on-line center to the subscribing station, the communications network including a communications portion in the on-line center and a communications portion in the subscribing station, and further includes an ability to connect the on-line center to the subscribing station through an external communications network and transmit the option key from the on-line center to the subscribing station in response to a user I.D. receipt and authorization, and a valid option request receipt.

11. (Original) The system of claim 10 further comprising a computer within the on-line center programmed to:

receive a user I.D. at the on-line center from a user and validate the user I.D.;

receive an option request from the user;

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if the user I.D. is validated, receive a system I.D. and validate the system I.D.;

if the system I.D. is validated, check whether the option requested was previously enabled; and

if the option requested was not previously enabled, enable the option requested.

12. (Original) The system of claim 11 wherein the computer is further programmed to generate an option key specific to the system I.D.

13. (Original) The system of claim 12 wherein the computer is further programmed to:

download and install the option key in medical equipment at the subscribing station; and

verify option enablement in the medical equipment.

14. (Original) The system of claim 13 wherein the computer is further programmed to send an electronic verification of the option enablement.

15. (Original) The system of claim 10 wherein the subscribing station includes at least one medical imaging device.

16. (Original) The system of claim 12 wherein the computer is further programmed to FTP or email the option key to a user identified by the user I.D. to allow the user to manually enable the option.

17. (Original) The system of claim 12 wherein the computer is further programmed to generate the option key with a disablement feature to disable the option after a predetermined time period.

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18. (Original) A computer program which, when executed by a computer, causes the computer to:

receive an option-enabling request from a user to request an option to be enabled in a medical device located remotely from an on-line center;

receive a system I.D. and validate the system I.D. with data from a database at the on-line center;

compare the option-enabling request with any other option requests for that system I.D. in the database at the on-line center and reject the option-enabling request if the comparison results in a predefined number of matches;

otherwise, generate an option key and forward the option key to one of the user and the medical device to enable the option.

19. (Original) The computer program of claim 18 wherein the generation of the option key includes creating a disabling feature to disable the option after a predetermined number of days.

20. (Original) The computer program of claim 18 wherein the computer program further causes the computer to receive and authenticate a user I.D. before receiving an option-enabling request.

21. (Original) The computer program of claim 18 wherein the predefined number of matches is one.

22. (Original) The computer program of claim 18 stored in memory of and incorporated into an on-line center that is connected to a plurality of subscribing stations, each subscribing station having at least one medical imaging scanner that has operational software that comprises modules, where at least one of the modules is optional and not operational and the option key is generated to automatically enable the at least one optional module.

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23. (Original) A computer data signal embodied in a carrier wave and representing a set of instructions which, when executed by at least one processor, causes the at least one processor to enable an option in a device by:

receiving a user I.D. at a centralized facility;

receiving an option-enabling request specifying an option requested to be enabled in the device at a subscribing station;

confirming that the option has not already been enabled; and if not,

sending an enabling feature from the centralized facility to the device in the subscribing station; and

activating the option in the device.

24. (Original) The computer data signal of claim 23 wherein the enabling feature is a software key designed to enable software already installed in the device.

25. (Original) The computer data signal of claim 23 wherein the device includes medical imaging scanners and further includes designing a software key to enable the option in the medical image scanner for a predetermined trial period.

26. (Original) The computer data signal of claim 23 further causing the acts of:

authenticating the user I.D. after receiving the user I.D. at the centralized facility; and

wherein the act of sending an enabling feature includes downloading the enabling feature to the equipment and remotely enabling the feature automatically and without further user input.